

REMARKS/ARGUMENTS

Applicant appreciates the Examiner's continued thorough search and examination of the present patent application.

As noted in applicant's previous responses, applicant assumes that the drawings submitted are acceptable for examination purposes. As such time as the applicant is notified that there is patentable subject matter in the present application, formal drawings will be supplied.

Claim 1 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses this rejection.

In particular, claim 1 is rejected under 35 U.S.C. §112, second paragraph on the grounds that the word "criteria" is not defined by the claims, and the word "semi-automatically" is similarly not defined by the claims. With respect to the term, "criteria," applicant respectfully submits that a recent search performed on the U.S. Patent and Trademark Office publicly accessible Internet web site uncovered 9,252 issued U.S. patents that include the term, "criteria," in one or more claims. Moreover, a search of the U.S. Patent and Trademark Office Internet web site uncovered 170 issued patents that include the term "semi-automatically," in one or more claims. Further, a search of the U.S. Patent and Trademark Office Internet web site revealed 65 issued patents, several of which issued in late 2004 and early 2005, that include the term, "substantially automatically."

The above provides conclusive evidence that the terms, "criteria," "semi-automatically," and "substantially automatically" are terms that do not render claims indefinite under 35 U.S.C. §112, second paragraph. Applicant respectfully requests that, since U.S. patents are public documents, the Examiner take official notice that the terms, "criteria," "semi-automatically," and "substantially automatically" are not indefinite in accordance with 35 U.S.C. §112, second paragraph.

Applicant notes that the Examiner has interpreted the term "criteria" as a "criteria" by the user for a standard on which a judgement or decision is based. Applicant respectfully disagrees

with the Examiner's interpretation of the term "criteria" because claim 1 recites the selection criteria established by "a selection criteria sub-system." The Examiner's interpretation that "criteria" is limited to a user employing a standard on which a judgement or decision is based is too narrow and restrictive. Accordingly, applicant respectfully requests the Examiner interpret the term, "criteria," to be established by a selection criteria sub-system for merchandise selection.

With respect to the term, "substantially," applicant uncovered 804,127 issued patents with one or more claims that include the term "substantially." With respect to the term, "substantially automatically," applicant respectfully submits that "substantially automatically" means, generally, it is overwhelmingly more likely that a process or feature of the invention will occur without or with minimal manual input from a user.

For the foregoing reasons, applicant respectfully submits that claim 1 is not indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as evidenced by hundreds and thousands of patents issued by the U.S. Patent and Trademark Office. For present purposes, applicant is reasonably satisfied with the Examiner's decision, for purposes of examination, to interpret the words "semi-automatically" and "substantially automatically" as generic phrases.

Claims 1-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over storefrontpro.com web pages captured via the WayBackMachine ("Storefront Pro") in view of Ross, Jr. (U.S. Patent No. 6,629,135). Applicant respectfully traverses this rejection.

Applicant's claim 1 defines a "website constructor" that includes a plurality of subsystems, including a "selection criteria subsystem," a "website organization subsystem," a "graphic design subsystem," a "merchandise selection subsystem," a "merchandise information downloading subsystem" and a "website builder." The "website organization subsystem" and "graphic design subsystem," respectively, define a "look and feel" and create "at least one website layout and features setup" for a website constructed by the website constructor. Moreover, the "selection criteria subsystem" establishes "criteria for merchandise selection" and the "merchandise selection subsystem" selects "merchandise offered for sale on the website constructed by the website constructor" that "matches the selection criteria" and is "based on

merchandise made available by a plurality of vendors[.]” The “merchandise information downloading subsystem” downloads “merchandise information” from “a plurality of vendors of merchandise[.]” The merchandise information defines “merchandise offered for sale on the website constructed by the website constructor that has been selected by the merchandise selector subsystem[.]”

Thus, a plurality of vendors provide merchandise offered for sale on a website constructed by the website constructor, based on selection criteria established by the selection criteria subsystem. Information regarding the merchandise provided by a plurality of vendors is downloaded by the merchandise information downloading subsystem.

Applicant respectfully submits that, for the reasons set forth below, the combination of elements defined in Applicant’s claim 1 is not taught or suggested by Storefront Pro, Ross, Jr., or both references combined.

The “Background of the Invention” section of applicant’s written specification identifies tedious, time-consuming and error-prone steps associated with designing and implementing an Internet web site, particularly for an on-line merchant. The specification also identifies problems associated with maintaining such a web site due to requirements associated with regular and/or frequent modifications.

Such issues with web site development and maintenance are no less real today as they were back in 2000, the year of the earliest claimed priority date of the present patent application. The various subsystems defined in applicant’s claim 1 “website constructor” provide solutions to these problems which are not taught or suggested in the prior art.

Applicant notes that of the seven example pages of Storefront Pro cited by the Examiner, two pages are blank and two pages include information and statistics regarding visitors to a web site. Thus, four of the seven pages are not at all suggestive of applicant’s claim 1. The remaining three pages, as discussed in detail below, do not teach or suggest features defined in applicant’s claim 1.

Storefront Pro, to the extent reported by the WayBackMachine, is an example of a typical prior art do-it-yourself e-commerce web site building product that purports to allow merchants to

“design,” “administer,” “automate back office ... business,” and provide “for electronic transactions” in an Internet web site. Storefront Pro claims to be more than a typical web page editor by storing product and sales information in databases, as well as by providing a “Store Administration Home Page” for maintaining a merchant’s web site. Options provided in the Store Administration Home Page include “Add a New Item,” “Modify or Delete an Item” and “Upload or Delete Product Images.” Such options represent typical prior art methods for populating a merchant’s web site with products for sale. More particularly, individual products are selected by the user, and individual virtual representations of the products (e.g., text and graphics) are provided via data entry in a form provided by Storefront Pro and by “uploading” images, such as by file transfer protocol (“FTP”) or other web interface.

As noted by the Examiner, the prior art solution taught by Storefront Pro is silent with respect to applicant’s claim 1 selection criteria subsystem, merchandise selection subsystem, and merchandise information downloading subsystem. Accordingly, applicant respectfully disagrees with the Examiner that Storefront Pro teaches applicant’s claim 1 “website builder” because claim 1 defines that the website builder builds a website based on the criteria and conditions that have been setup by the “selection criteria subsystem,” the “website organization subsystem,” the “graphic design subsystem,” the “merchandise selection subsystem” and the “merchandise information downloading subsystem” (i.e., the “foregoing subsystems”). Storefront Pro does not teach or suggest these features, and thus does not teach or suggest applicant’s claim 1 “website builder.”

Moreover, applicant respectfully disagrees with the Examiner’s statement at page 4 of the Office Action that “it is implicit in Storefront that a merchant would establish a criteria for selecting merchandise[.]” Throughout time, merchants have relied on criteria for selecting merchandise, such as a shoe merchant selecting shoe-related items (to borrow from the Examiner’s example), but such criteria is not implicit, taught or even suggested in Storefront Pro. As noted above, Storefront Pro requires that merchants add (or delete) individual items for sale on the merchant’s web page via the Store Administration Home Page. Continuing with the Examiner’s example, if the shoe merchant were to add a fire hose to the web site via Storefront

Pro, the fire hose would be simply listed in the site. Therefore, there is nothing implicit in Storefront Pro with regard to criteria.

As noted by the Examiner, Storefront Pro does not disclose or teach Applicant's claim 1 selection criteria subsystem, merchandise selection subsystem, or merchandise information downloading subsystem. Accordingly, the Examiner cites to Ross, Jr. for teaching the elements of Applicant's claim 1 that are missing from Storefront Pro. Following a careful review of Ross, Jr., however, applicant respectfully submits that Ross, Jr. does not teach or suggest those features in Applicant's claim 1 that are missing from the teachings of Storefront Pro.

Ross, Jr. is directed to an application of Internet-related technology that is very different from the invention defined in applicant's claim 1. Ross, Jr. regards a "new paradigm of co-marketing on the Internet," an area of e-commerce not addressed by applicant's claim 1. More particularly, Ross, Jr. teaches an on-line affiliate commerce system that purports to overcome the limitations of prior art on-line affiliate commerce systems, particularly with respect to Internet commerce web sites (referred to as "hosts") that let third-party website owners list a subset of their goods "within [the host providers'] websites" (see column 2, lines 7-18). Ross, Jr. provides benefits for affiliates, for example, by attempting to balance benefits typically afforded to host providers by preventing the loss of "hard-won visitor traffic" (column 2, lines 51-63). Alternatively, Ross, Jr. states, at column 3, lines 1-5, that merchants can focus on product development, production and order fulfillment and "leave the exploration of the Internet to experts." More particularly, the invention described by Ross, Jr. "obviates the need" for merchants to invest in their own "unique Internet presence" by providing a system that provides an interface having the look and feel to that of a host. Thus, applicant respectfully submits that Ross, Jr. addresses and purports to solve problems that are very different from applicant's claim 1, and does not teach or suggest features of applicant's claim 1 that are missing from the teachings of Storefront Pro.

Ross, Jr. seeks to improve affiliate commerce systems in which hyperlinks to "e-commerce supported pages" are embedded within a host provider's web site to enable a visitor to the host's web site to purchase a product offered for sale by an affiliate. The e-commerce

supported pages are generated by Ross, Jr.'s system, and have the same look and feel of the host provider's web site, thereby providing a "transparent" interface that appears the same as the host provider's web site to the on-line shopper. Unlike applicant's claim 1 features (i.e., "selection criteria sub-system," "merchandise selection sub-system," "merchandise information downloading sub-system" and "website builder"), Ross, Jr. regards placement of hyperlinks in a host's web site to enable on-line shoppers to purchase a product offered for sale by an affiliate merchant via an e-commerce supported page.

The Examiner cites to column 1, lines 31-31, column 14, lines 39-41 and column 24, lines 44-47 of Ross, Jr. for teaching the merchandise selection sub-system defined in applicant's claim 1. Applicant respectfully disagrees. With respect to these passages, column 1, lines 31-31 regards the prior art practice of embedding hyperlinks on a web site. Further, column 14, lines 39-41 also regards placement of hyperlinks within a host's web site, with particular emphasis on whether the host has previously linked 720 to the merchant or to a merchant to "whom a previous link does not exist 715. Lines 39-41 regard the case in which a previous link does not exist, and an extra optional step is involved to approve the host with respect to the new merchant as part of a catalog selection process 745. The focus on the cited passage, therefore, is not on applicant's merchandise selection sub-system that matches selection criteria at least semi-automatically based on merchandise made available by a plurality of vendors, but rather on steps for approving the host with respect to a new merchant who is seeking to become an affiliate member of the host. Two sentences further in the same column (ending at line 42) Ross, Jr. teaches that in linking to a merchant to whom a previous link does exist space 720, "a catalog may implicitly be selected." Applicant respectfully submits that this implicit selection of a catalog is patentably distinct from applicant's merchandise selection sub-system that selects merchandise offered for sale on the web site that matches selection criteria. Instead, Ross, Jr. teaches that if a merchant has linked to a host in a previous affiliate arrangement, the catalog provided by the merchant may implicitly be selected.

With respect to column 24, lines 44-47, applicant respectfully submits that the cited passage relates to an internal system transaction flow, wherein a user is not made aware that his

“shopping experience is taking place on an outsourced server.” In other words, and as cited at line 50 of column 24, the customer is browsing through featured items in the merchant’s catalog, while maintaining the look and feel of the host. Applicant submits that this is patentably different from applicant’s merchandise selection system in the web site constructor that selects merchandise offered for sale on the web site constructed by the web site constructor then matches the selection criteria at least semi-automatically.

With respect to applicant’s merchandise information downloading sub-system, the Examiner cites to column 14, lines 41-60. This cited passage in Ross, Jr. regards the processes associated with providing hyperlinks to merchants that are affiliates of a host. As noted above, applicant’s claim 1 merchandise information downloading sub-system downloads information regarding merchandise substantially automatically, and does not regard an affiliate system in which merchants sell goods by providing hyperlinks on a host system that, when selected, appear to the user in the look and feel of the host system.

Thus, nowhere in the specific passages in Ross, Jr. cited by the Examiner, nor elsewhere in the reference is a teaching or suggestion of applicant’s claim 1 features (i.e., “selection criteria sub-system,” “merchandise selection sub-system,” “merchandise information downloading sub-system” and “website builder”).

Applicant respectfully submits that, for the forgoing reasons, the combination of Storefront Pro and Ross, Jr. does not teach or suggest applicant’s claim 1. Even assuming that one would combine the teachings of Storefront Pro and Ross, Jr., Applicant’s claim 1 still would not be taught. Instead, the result would be a web site creation tool in which e-commerce support pages containing products are developed having an interface that has the look and feel of a host’s web site. Applicant’s claim 1 features (i.e., “selection criteria sub-system,” “merchandise selection sub-system,” “merchandise information downloading sub-system” and “website builder”) would not be the result.

Moreover, applicant respectfully submits that one skilled in the art would not be motivated to combine Storefront Pro with Ross, Jr. as the Examiner has done. As noted above, Ross, Jr. teaches that merchants can use the invention taught by Ross, Jr. to forego an Internet

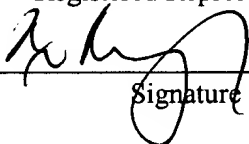
web presence because the system taught by Ross, Jr. "obviates the need" for an Internet presence. The subject matter described in Ross, Jr. regards on-line affiliate systems and creation of e-commerce support pages having a look and feel of a host web site, and, therefore, one skilled in the art of designing and implementing an e-commerce web site via Storefront Pro would have no motivation to combine Storefront Pro with the teachings of Ross, Jr.

Accordingly, it is respectfully submitted that claim 1 and all its dependent claims clearly define over the prior art. Therefore, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on May 19, 2005:

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Name of applicant, assignee or
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Signature

May 19, 2005

Date of Signature

MM:JJF:ck

Respectfully submitted,


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